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In re application of Christopher W. Ogden :
Serial No. : 09/933,548 : DECISION ON PETITION
Filed : August 20, 2001 :
Attorney Docket No.: NORT 100 :

This is in response to applicants' petition, filed October 1, 2003 under 37 CFR 1.144, requesting withdrawal of the restriction requirement set forth by the examiner.

BACKGROUND

A review of the file history shows that this application was filed under 35 U.S.C. 111(a) as a continuation of PCT/GB00/00586, filed February 21, 2000, which claims priority to U.K. application 99.03841.6, filed February 20, 1999. The application, as filed with preliminary amendments, contained claims 1-38. In a first Office action mailed April 22, 2003 the examiner set forth a restriction requirement under 35 U.S.C. 121 dividing the claims into 10 groups.

In the response filed May 22, 2003, applicants elected Group I, claims 1-9, 15 and 16, drawn to a method of determining susceptibility to prostate cancer using nucleic acids. Applicant traversed the restriction on essentially the same grounds presented in the instant petition. On July 1, 2003 the examiner mailed a first Office action on the merits, wherein the restriction requirement was made final. Applicants have since filed a response to the outstanding Office action on October 31, 2003.

DISCUSSION

MPEP 1893.03(d) states, in part:

[U]nity of invention (not restriction) practice is applicable in international applications (both Chapter I and II) and in national stage applications submitted under 35 U.S.C. 371. Restriction practice continues to apply to U.S. national applications filed under 35 U.S.C. 111(a), even if the application filed under 35 U.S.C. 111(a) claims priority to an earlier

international application or to an earlier U.S. national stage application submitted under 35 U.S.C. 371.

In their initial response and in the petition, applicants argue that the various inventions identified by the examiner have unity of invention. This argument is not persuasive because the unity of invention standard does not apply to applications filed under 35 U.S.C. 111(a).

Applicants argue, "It is well established that the same claims cannot be divided into separate inventions" (petition, p. 3). This argument is unsupported by statute, regulation or case law, and is therefore unpersuasive. Applicants are referred to MPEP 809.03 for a discussion of linking claims. Furthermore, applicants are reminded that elected claims 1-4, 15 and 16 were designated as linking claims in the restriction requirement, and these claims will be examined in their entirety should the elected invention be found allowable.


DECISION

Applicant's petition is **DENIED** for the reasons set forth above.

The application will be forwarded to the examiner for consideration of the response filed October 31, 2003.

Any request for reconsideration or review of this decision must be made by a renewed petition and must be filed within TWO MONTHS of the mailing date of this decision in order to be considered timely.

Should there be any questions with regard to this letter please contact Bruce Campell by letter addressed to the Director, Technology Center 1600, P.O. Box 1450, Alexandria, VA, 22313-1450, or by telephone at (571) 272-0974 or by facsimile transmission at (571) 273-0974.

John Doll 
Director, Technology Center 1600